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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,803	06/28/2006	Reiner Fischer	2400.0150000/VLC/CMB	5333
26111 7590 04/15/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
BROOKS, KRISTIE LATRICE				
ART UNIT		PAPER NUMBER		
1616				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/563,803

**Applicant(s)**

FISCHER ET AL.

**Examiner**

KRISTIE L. BROOKS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1,3 and 8 are pending.
2. Receipt and consideration of Applicants amendments/remarks December 18, 2009 is acknowledged.
3. Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

### ***Claim Rejections – 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wachendorff et al., BAJ 2740, a novel broad spectrum acaricide, Proceedings of the Brighton Crop Protection Conference-Pests and Diseases, pp.53-58, 2000.

Wachendorff et al. teach BAJ 2740 (also called spiroadiclofen) as a novel acaricide with a broad spectrum of activity, long lasting efficacy, favorable

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environmental profile and good plant compatibility in all relevant crops (see the abstract). BAJ 2740 (also called spiroadiclofen) is useful on crops such as citrus, stone and pome fruits, grapes, and nuts, for example (see the abstract). Table 5 discloses the application of BAJ 2740 on grapes (see page 57).

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(a) as being anticipated by Elbert et al., Worldwide uses of the new acaricide Envidor® in perennial crops, Pflanzenschutz-Nachrichten Bayer, 55, 2002, 287-304.

Elbert et al. teach Envidor®, common name spiroadiclofen (i.e. instant compound of formula (I)), provides excellent acaricidal control on fruits such as citrus, pome and stone fruits, grapes and almonds (see the introduction). The application of Envidor® to fruits such as grapes, and almonds, provided excellent mite control (see Tables 2 and 4, 3.2.2 Almonds on page 292, and 3.4.2. Grapes on page 294). Elbert et al. teach that spiroadiclofen will be registered for use with the following crops: coffee, coconut, tomato, papaya and apple (see page 290).

### ***Response to Arguments***

Applicant's arguments filed December 19, 2009 have been fully considered but they are not persuasive.

Applicant argues that Wachendorff et al. and Elbert et al. do not teach the application of spiroadiclofen on hops, soft fruits, or conifers.

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Applicant's argument is not convincing. As stated above, both Wachendorff and Elbert et al. teach the application of spirodiclofen on grapes. It is known in the art that grapes are a soft fruit (as evidenced by Callender, Chemistry of grapes and other fruits as the raw materials involved in winemaking, Advances in Chemistry, Vol. 137, pgs 11-49, 1974) (see page 13, first two lines). Thus, the teachings of Wachendorff et al. and Elbert et al. encompass soft fruits, as instantly claimed.

Therefore, Applicant's arguments of nonobviousness are not persuasive and the rejection is maintained.

### ***New Grounds of Rejection***

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wachendorff et al., BAJ 2740, a novel broad spectrum acaricide, Proceedings of the Brighton Crop Protection Conference-Pests and Diseases, pp.53-58, 2000 in view of Weidhaas, Spider Mite and Other Acarina on Trees and Shrubs, Journal of Arboriculture, 5(1): January 1979, pgs. 9-15.

### **Application Claims**

Applicant claims a method of controlling acaricides comprising contacting a compound of formula (I) with hops, soft fruits, or conifers.

### **Determination of the scope and content of the prior art**

#### **(MPEP 2141.01)**

Wachendorff et al. teach BAJ 2740 (also called spirodiclofen) as a novel acaricide with a broad spectrum of activity, long lasting efficacy, favorable environmental profile and good plant compatibility in all relevant crops (see the abstract). BAJ 2740 (also called spirodiclofen) is useful on crops such as citrus, stone and pome fruits, grapes, and nuts, for example (see the abstract). Table 5 discloses the application of BAJ 2740 on grapes (see page 57). Wachendorff et al teach that BAJ 2740 (also called spirodiclofen) provides excellent control of important mite pests such as *Panonychus* spp., *Phyllocopiruta* spp., *Brevipalpus* spp., and *Aculus* and *Tetranychus* species (see the abstract).

**Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)**

Wachendorff et al. teach the use of spiroadiclofen on various crops but do not specifically teach the use of spiroadiclofen on conifers. This deficiency is cured by the teachings of Weidhaas.

Weidhaas teaches spider mites of the family *Tetranychus* spp., *Panonychus* spp., etc., can cause serious damage in forest trees (e.g. elm and linden) and shrubs (see the entire article, especially the introduction, Elm spider mites and Linden mites on page 11 and 12, and the Two-spotted mite on page 12).

**Finding of prima facie obviousness  
Rational and Motivation (MPEP 2142-2143)**

One of ordinary skill in the art would have been motivated to apply the instant compounds to conifers (elm, linden, shrubs) because it is known in the art that mites of the *Panonychus* spp., *Aculus* and *Tetranychus* species can cause serious damage in trees (e.g. elms, linden) and shrubs, as suggested by Weidhaas. It is also known in the art that BAJ 2740 (also called spiroadiclofen) provides excellent acaricide control of *Panonychus* spp., *Aculus* and *Tetranychus* species, as suggested by Wachendorff et al.

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the instant compound to conifers because they are an obvious variation of plants and trees that would benefit from the control of *Panonychus* spp., *Aculus* and *Tetranychus* mite species by killing mites of the *Panonychus* spp., *Aculus* and *Tetranychus* species and preventing an infestation.

Therefore, the claimed invention would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

### ***Response to Arguments***

Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. No claims are allowed.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie L. Brooks whose telephone number is (571) 272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax



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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616